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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/068,238	03/26/1999	Udo Nobel	766X89029IN	2114

7590 07/08/2004

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EXAMINER

CHENEVERT, PAUL A

ART UNIT

PAPER NUMBER

3612

DATE MAILED: 07/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/068,238

Applicant(s)

NOBEL ET AL.

Examiner

Paul A. Chenevert

Art Unit

3612

NW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 12 and 14-27 is/are rejected.
- 7) ☒ Claim(s) 10, 11 and 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 15.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered. In specific, no copy of EP 545 896 (page 2, line 4) has been presented.

### ***Drawings***

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: "36" in Figures 4 & 5 (see page 11, line 14). A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Specification***

4. The disclosure is objected to because of the following informalities:

- a. Page 9, line 37, "24" should be changed to "29".
- b. Page 11, line 31, "17" should be changed to "37".
- c. Page 11, line 32, "12" should be changed to "32".
- d. Page 15, line 2, "first" should be changed to "second".

Appropriate correction is required.

***Claim Objections***

5. Claims 12, 13, & 18-22 are objected to because of the following informalities:

- a. Claim 12, line 5, "it" should be changed to "the glazing".
- b. Claim 18, line 5, "sald" should be changed to "said".

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

7. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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- a. Claim 2 recites the limitation “raised portion” on line 2. A raised portion has already been presented in depended upon claim 1. It is unclear if this is a new portion. It is suggested to either changed “raised portion” in claim 1 to “seal element” or another descriptive term or else delete “a raised portion in the form of” in claim 2.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-5, 12, 14-17, & 23-27 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Schroter.

Schroter discloses in Figure 2 a profile (10) comprising a seal element (11) having three slanted edges, which center a vehicle window (1) on installation onto a mounting flange (7) with adhesive (12) located between two raised portions and a sealing lip (located below 10).

10. Claims 1 & 6 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Pfadenhauer.

Pfadenhauer discloses in Figure 4 a profile (10) comprising raised a curled lip portion (15), which centers a vehicle window (3) on installation with adhesive (5) onto a mounting flange (2).

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*Claim Rejections - 35 USC § 103*

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 7 & 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pfadenhauer in view of Ohlenforst et al.

Pfadenhauer discloses a profile with a curved sealing lip portion.

However, Pfadenhauer does not expressly disclose that the profile including a cord to pull the curved portion up over the mounting flange.

Ohlenforst et al. disclose a profile (37) having a sealing lip (40) placed over a mounting flange (41) by a cord (38).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the profile of Pfadenhauer, to employ a cord installation, as taught by Ohlenforst et al.

The suggestion/motivation for doing so would have been to improve the installation procedure, as is desired in this vehicle invention.

Therefore, it would have been a desirable and thus a prima facie obvious modification of the profile by combining a cord installation with the curved lip seal portion to obtain the invention as specified in claims 7 & 9, as taught by the prior references' motivation, and not hindsight from the applicants disclosure.

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13. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pfadenhauer in view of Ohlenforst et al. and obvious common knowledge.

Pfadenhauer discloses a profile with a curved sealing lip portion.

However, Pfadenhauer does not expressly disclose that the profile including a cord to pull the curved portion up over the mounting flange

Ohlenforst et al. disclose a profile (37) having a sealing lip (40) placed over a mounting flange (41) by a cord (38).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the profile of Pfadenhauer, to employ a cord installation, as taught by Ohlenforst et al.

The suggestion/motivation for doing so would have been to improve the installation procedure, as is desired in this vehicle invention.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a metal cord, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious mechanical expedient choice. *In re Leshin*, 125 USPQ 416.

Therefore, it would have been a desirable and thus a prima facie obvious modification of the profile by combining a metal cord installation with the curved lip seal portion to obtain the invention as specified in claim 8, as taught by the prior references' motivation, and not hindsight from the applicants disclosure.

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14. Claims 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schroter in view of Pfadenhauer.

Schroter discloses a profile as described above.

However, Schroter does not expressly disclose that the seal element is in the shape of a curled lip.

Pfadenhauer discloses a profile with a curved sealing lip portion having a tapered thickness with three decreasing thickness from the base to the tip.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the profile of Schroter, to employ a curled seal element, as taught by Pfadenhauer.

The suggestion/motivation for doing so would have been to improve the seal element's ease of installation, as is desired in this vehicle invention.

Therefore, it would have been a desirable and thus a prima facie obvious modification of the profile by combining a curled seal element with the profile base to obtain the invention as specified in claim 18, as taught by the prior references' motivation, and not hindsight from the applicants disclosure.

15. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schroter, as modified, in view of Hill et al.

Schroter, as modified, discloses a profile as described above including two spacers.

However, Schroter, as modified, does not expressly disclose that the spacers are of various heights.

Hill et al. discloses a profile with two spacers having various heights.



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At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the profile of Schroter, as modified, to employ variable height spacers, as taught by Hill et al.

The suggestion/motivation for doing so would have been to better contain the adhesive from spreading into the vehicle compartment, as is desired in this vehicle invention.

Therefore, it would have been a desirable and thus a prima facie obvious modification of the profile by combining variable height spacers with the profile base to obtain the invention as specified in claim 22, as taught by the prior references' motivation, and not hindsight from the applicants disclosure.

*Allowable Subject Matter*

16. Claims 10, 11, & 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

17. The following is a statement of reasons for the indication of allowable subject matter: the prior art does not show or make obvious Applicant's tear-off tip, contained electrical wire, or interior groove.

*Conclusion*

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. Chenevert whose telephone number is 703-305-0837. The examiner can normally be reached on Mon-Fri (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn D. Dayoan can be reached on 703-308-3102. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Paul A. Chenevert  
Examiner  
Art Unit 3612

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5/28/04

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